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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,589	01/24/2002	Prasad Nimmagadda	9400-235CT (98033)	3799
39072	7590	03/24/2006	EXAMINER	
MYERS BIGEL SIBLEY & SAJOVEC, P.A. P.O. BOX 37428 RALEIGH, NC 27627			TRAN, THIEN D	
			ART UNIT	PAPER NUMBER
			2616	

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary <i>Supplemental</i>	Application No.	Applicant(s)	
	10/057,589	NIMMAGADDA, PRASAD	
	Examiner	Art Unit	
	Thien D. Tran	2665	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2006.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 6, 12, 13, 16, 19, 23, 25, 28, 34, 35, 38, 41, 44, 59, 60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 6, 12, 13, 16, 19, 23, 25, 28, 34, 35, 38, 41, 44, 59, 60 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 7, 8, 11, 14, 20 of U.S. Patent No. 6,426,961. Although the conflicting

claims are not identical, they are not patentably distinct from each other because the application's claims merely broaden the scope of the patented claims by not claiming some elements.

The following is the comparison between the patented claims and the claims in the instant application, (1 and 1, 28, 60), (7 and 6, 34), (9 and 35), (11 and 13, 16, 38), (14 and 19, 22, 41), (20 and 25, 44, 59).

The limitations of the claims in the Patent No. 6,426,961 are not recited in the claims of the instant application: regarding claim 1 " In an asymmetrical digital subscriber line (ADSL) system used in the local loop between a telecommunications network and a customer's premises, the ADSL system being connected to a telecommunications device at the customer's premises and providing a voice service of the ADSL system being in use with respect to the telecommunications device, and the ADSL system including an ADSL modem functionally connected to a computer at the customer's premises, a method to operate a data service of the ADSL system pursuant to a selected mode of operation of the data service, the method comprising the steps of: A. causing the ADSL modem to make a detection of the voice service in use with respect to the telecommunications device at the customer's premises; B. in response to the detection, causing the ADSL modem to provide the detection to the computer; C. in response to receiving the detection from the ADSL modem, causing the computer to display a list of modes of operation; D. receiving at the computer a selected mode from the list; E. causing the computer to provide the ADSL modem with instructions to operate the data service pursuant to the selected mode; and F. in response to

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receiving the instructions, causing the ADSL modem to interact with the ADSL system so as to provide the data service is operated pursuant to the selected mode of operation".

The limitations of the claims in the Patent No. 6,426,961 are not recited in the claims of the instant application: regarding claim 7 "In an asymmetrical digital subscriber line (ADSL) system used in the local loop between a telecommunications network and a customer's premises, the ADSL system being connected to a telecommunications device at the customer's premises and a voice service of the ADSL system being in use with respect to the telecommunications device, and the ADSL system including an ADSL modem functionally connected to a computer at the customer's premises, a method to operate a data service of the ADSL system pursuant to a preselected mode of operation of the data service, the method comprising the steps of: A. causing the ADSL modem to make a detection of the voice service in use with respect to the telecommunications device at the customer's premises; B. in response to the detection, causing the ADSL modem to provide the detection to the computer; C. in response to receiving the detection from the ADSL modem, causing the computer to check for a preselected mode of operation; D. in response to finding the preselected mode of operation; E. causing the computer to provide the ADSL modem with instructions to operate the data service pursuant to the preselected mode of operation; and F. in response to receiving the instructions, causing the ADSL modem to interact with the ADSL system so as to operate the data service pursuant to the preselected mode of operation".

The limitations of the claims in the Patent No. 6,426,961 are not recited in the claims of the instant application: regarding claim 9 "In an asymmetrical digital subscriber line (ADSL) system used in the local loop between a telecommunications network and a customer's premises, the ADSL system including an ADSL modem functionally connected to a computer at the customer's premises, a data service of the ADSL system being in use through the ADSL modem to the computer, and the ADSL system also being connected to a telecommunications device at the customer's premises, a method to provide impact information on performance of the data service in light of concurrent use of a voice service of the ADSL system, the method comprising the steps of: A. causing the ADSL modem to make a detection of an off-hook indication with respect to the telecommunications device; B. in response to the detection, causing the ADSL modem to provide the detection to the computer; and C. in response to receiving the detection from the ADSL modem, causing the computer to provide impact information on performance of the data service in light of concurrent use of the voice service".

The limitations of the claims in the Patent No. 6,426,961 are not recited in the claims of the instant application: regarding claim 11 "In an asymmetrical digital subscriber line (ADSL) system used in the local loop between a customer's premises and a telecommunications network serving the customer's premises, the ADSL system including an ADSL modem functionally connected to a computer at the customer's premises, a data service of the ADSL system being in use through the ADSL modem to the computer, and the ADSL system also being connected to a telecommunications

device at the customer's premises for voice service to the telecommunications device, a method to provide impact information on performance of one service as between the data service or the voice service in light of concurrent use of the other service, the method comprising the steps of: A. causing a detection by the telecommunications network of an off-hook indication with respect to the telecommunications device; B. in response to the detection, causing the telecommunications network to make a determination that the data service is in use at the customer's premises; and C. in response to the determination, causing the telecommunications network to provide an announcement including impact information on performance of the one service in light of the concurrent use of the other service".

The limitations of the claims in the Patent No. 6,426,961 are not recited in the claims of the instant application: regarding claim 14 "In an asymmetrical digital subscriber line (ADSL) system used in the local loop between a customer's premises and a telecommunications network serving the customer's premises, the ADSL system including an ADSL modem functionally connected to a computer at the customer's premises, a data service of the ADSL system being in use through the ADSL modem to the computer, and the ADSL system also being connected to a telecommunications device at the customer's premises for voice service to the telecommunications device, a method to provide impact information on performance of one service as between the data service or the voice service in light of concurrent use of the other service, the method comprising the steps of: A. causing a detection by the telecommunications network of an off-hook indication with respect to the telecommunications device; B. in

response to the detection, causing the telecommunications network to make a determination that the data service is in use at the customer's premises; and C. in response to the determination, causing the telecommunications network to provide an announcement including impact information on performance of the one service in light of the concurrent use of the other service”.

The limitations of the claims in the Patent No. 6,426,961 are not recited in the claims of the instant application: regarding claim 19 “In a telecommunications network, and particularly in an asymmetrical digital subscriber line (ADSL) system used in the local loop between the telecommunications network and a customer's premises, the ADSL system being connected to a telecommunications device at the customer's premises and a voice service of the ADSL system being in use with respect to the telecommunications device, and the ADSL system including an ADSL modem functionally connected to a computer at the customer's premises, a system to operate a data service of the ADSL system pursuant to a selected mode of operation of the data service, the system comprising: A. the ADSL modem being operative to make a detection of the voice service being in use with respect to the telecommunications device at the customer's premises and to provide the detection to the computer; B. the computer being operative, in response to receiving the detection from the ADSL modem i. to display a list of modes of operation, ii. to receive a selected mode from the list, and iii. to provide the ADSL modem with instructions to operate the data service pursuant to the selected mode; and C. the ADSL modem being further

operative, in response to receiving the instructions, to interact with the ADSL system so as to operate the data service pursuant to the selected mode of operation”.

The limitations of the claims in the Patent No. 6,426,961 are not recited in the claims of the instant application: regarding claim 20 “In an asymmetrical digital subscriber line (ADSL) system between a customer's premises and a telecommunications network serving the customer's premises, the ADSL system including a first ADSL modem functionally connected through twisted pair wiring to a second ADSL modem, the first ADSL modem also being functionally connected to the telecommunications network, the second ADSL modem also being functionally connected to a computer at the customer's premises for the provision of data service to the customer's premises, and the ADSL system also being connected through the twisted pair wiring to a telecommunications device at the customer's premises for voice service to the telecommunications device, a system to provide impact information on performance of one service as between the data service or the voice service in light of concurrent use of the other service, the system comprising: A. a switch in the telecommunications network being operative to detect an off-hook indication with respect to the telecommunications device, to communicate with the first ADSL modem to make a determination that the data service is in use at the customer's premises, and to send a message to an intelligent peripheral in the telecommunications network regarding the off-hook indication; and B. the intelligent peripheral in the telecommunications network being operative to respond to the message from the switch by providing an announcement including impact information on performance of

the one service in light of the concurrent use of the other service to the telecommunications device”.

The application's claims are nearly identical in every other respect to the patented claims. Therefore, the application's claims are simply broader version of the patented claims. It is the examiner's position that broadening the patented claims by not claiming the above elements of the patented claims would have been obvious to one of the ordinary skill in the art in view of the patented claim. It is important to note that the instant application is a continuation of the patent application, which yielded the patent (U.S. Patent No. 6,426,961) used herein as the basis for the obviousness type of double patenting rejection. The application is attempting to broaden the parent application's claims by eliminating some the claimed elements in the continuation at issue here.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 4, 5, 28, 29, 30, 32-34, 41, 60, are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bremer et al** (U.S Patent No 6,061,392) in the view of **Dunn et al** (U.S Patent No 6,118,780).

Regarding claims 1, 28, 34, 41, 60, **Bremer** discloses an asymmetrical digital subscriber line (ADSL, col.6 lines 40-50) system used between a telecommunications network and a customer's premises, the ADSL system being available to provide voice service and data service to the customer's premises, one service as between the voice service or the data service being in use with respect to the customer's premises (figures 3), a method comprising the steps of:

causing the ADSL system to detect a request for the other service (detecting an off-hook, col.8 lines 5-10);

causing the ADSL system to provide the other service to the customer's premises.

Bremer does not disclose that an ADSL system provides a choice having a list of modes of an operation, detecting of a selected mode from the list and provides the other service to the customer's premises pursuant to the selected mode.

Dunn discloses that an ADSL system provides the list of modes of the operation detecting of a selected mode from the list and provides the other service to the customer's premises pursuant to the selected mode (abstract, fig.3c2, col.2 line 15 to line 20 and col.4 line 30 to line 60). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add the feature of **Dunn's** system to **Bremer's** system to have a better performance of the system in enable users to modify their services without assistance of providing company operators. See Dunn, col.1 line 15 to line 20.

Regarding claims 4, 5, 29, 32, 33, **Bremer** and **Dunn** disclose the ADSL system that has a display of the list of available modes of operation (See Dunn, figure.3c2). However, Bremer and Dunn do not disclose the list containing a low power mode or full power or waiting mode. It would have been obvious to one having ordinary skill in the art at the time the invention was made to add a low power mode or full power mode in the list because it is a design of choices to include it in the system.

Conclusion

4. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Thien Tran whose telephone number is (571) 272-3156. The examiner can normally be reached on Monday-Friday from 8:30AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doris To, can be reached on (571) 272-7629. Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

5. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

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Patent Examiner

Thien Tran

DUC HO
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'Duc Ho', with a long horizontal stroke extending to the right.

3-23-06